

with said reinforcing bar and cement receiving cavities of conventional concrete blocks;

b) installing said mounting device into said concrete block wall in place of a conventional concrete block, said mounting device being placed into said concrete block wall in a manner such that said reinforcing bar receiving cavity of said mounting device is aligned with at least one reinforcing bar receiving cavity of a said concrete block;

c) providing at least one vertical reinforcing bar that is insertable through one of said reinforcing bar receiving cavities of said concrete block and said reinforcing bar and cement receiving cavity of said mounting block;

d) inserting said at least one vertical reinforcing bar into one of said reinforcing bar receiving cavities of said concrete block and said reinforcing bar and cement receiving cavity of said mounting device;

e) providing a cementing slurry;

f) pouring said cementing slurry into said reinforcing bar receiving cavities of said concrete block and said reinforcing bar and cement receiving cavity of said mounting device;

g) waiting a period of time sufficient to allow said cementing slurry to harden; and

h) permanently affixing a fixture to one of said plate members of said mounting device.

#### REMARKS

##### *Summary Of Prior Office Action*

In the October 20, 1999 Office Action, claims 1-10, 13, 18, 19, 21, 22 and 25 were rejected, but only claims 1-4, 8-10 and 18-22 stand rejected in view of prior art. Claims 5-7, 13 and 25 were indicated as containing allowable subject matter, but rejected under 35 U.S.C. §112. Claims 11, 12, 14-17, 23, 24, 26 and 27 were allowed, while claim 20 was objected to

as depending from a rejected base claim. Reexamination and reconsideration of these rejections are respectfully requested in view of the above-amendments and the following comments.

### ***Status of Claims***

Currently, claims 1-3, 5-9 and 11-27 are pending in the above-identified reissue application. Claims 1-3, 5-9 and 11-17 are the original patent claims with claims 1-3, 5, 9, 13 and 17 being amended. Claims 18-27 are new patent claims with claims 18-20, 22 and 25 being amended. Accordingly, after entrance of this Amendment, original patent claims 1-3, 5-9 and 11-17 and new application claims 18-27 are pending for consideration and examination. Original patent claims 1, 5 and 11 are independent claims. Also new application claims 18, 20, 23, 25 and 27 are independent claims.

### ***Explanation of Support in the Disclosure of the Patent for the Amendments***

The amendments to claim 1 is fully supported by the patent in the specification at column 7, lines 34-39, and in the drawings in Figures 1 and 3. Basically, claim 1 has been amended to recites (1) the first and second metal plate member being a one-piece unitary member; (2) three spacer members rigidly and fixedly secured between the first inner surface and the second inner surface in a manner to form a pair of reinforcing bar and cement receiving cavities and a pair of end cavities between the first and second metal plate members; and (3) the pair of reinforcing bar and cement receiving cavities and the pair of end cavities being alignable with reinforcing bar and cement receiving cavities of conventional concrete blocks.

The amendments to claims 2, 3 and 9 correct obvious errors, which are supported by the patent in the specification at column 4, lines 30-44, and in the drawings at Figures 1 and

2. Basically, claims 2, 3 and 9 have been amended to change "length" to --width-- and/or "width" to -- length --.

The amendments to claim 5 are fully supported by original patent claim 5. Claim 5 has been amended to be placed in independent form, including the limitations of original claim 1 but not intervening claim 3.

The amendments to claims 13, 19, 22 and 25 correct obvious errors, which are clearly supported by original independent claim 11. New claim 19 is fully supported by the patent in the specification at column 6, lines 63-67, and column 7, lines 1 and 2, and in the drawings at Figure 3. New claim 22 is fully supported by the patent in the specification at column 7, lines 33-39, and in the drawings at Figure 3. New claim 25 is fully supported by the patent in the specification at column 8, lines 20-37, and in the drawings at Figure 3. Basically, claims 13, 19, 22 and 25 have been amended to recites pair of spacer members instead of "first and second" spacer members. Claims 19, 22 and 25 also have been amended to remove the word "vertical" before the "spacer members". Finally, claim 25 has been amended to be placed in independent form, including the limitations of original claim 18.

The amendment to claim 17 corrects an obvious error, which is fully supported by original patent claim 17. In particular, claim 17 has been amended to change "atop" to -- a top --.

Basically, claim 18 has been amended to recites (1) the first and second metal plate member being a one-piece unitary member; (2) a pair of spacer members rigidly and fixedly secured between the first inner surface and the second inner surface in a manner to form at least one reinforcing bar and cement receiving cavities and a pair of end cavities between the first and second metal plate members; and (3) the pair of reinforcing bar and cement receiving cavities and the pair of end cavities being alignable with reinforcing bar and cement receiving

cavities of conventional concrete blocks. Also claim 18 has been amended to remove the word "vertical" before the "spacer members". Claim 18 is fully supported by the patent in the specification at column 6, lines 32-56 (Claim 1), and in the drawings at Figures 1 and 2.

Claims 20 and 25 have been amended to be placed in independent form, including the limitations of new claim 18 as previously presented. Claim 20 is fully supported by the patent in the specification at column 7, lines 3-14, and in the drawings at Figures 1 and 6.

Accordingly, Applicant believes that the amendments to original patent claims 1-3, 5, 9, 13 and 17 and new claims 18-20, 22 and 25 are fully supported by U.S. Patent Number 5,649,391 and that no new matter has been added.

#### ***Surrender of the Original Patent***

In paragraph 2 of the Office Action, it was noted that this reissue application was filed without the required Offer to surrender the original patent or, if the original is lost or inaccessible, an Affidavit or Declaration to that affect. Applicant respectfully disagrees with this indication. Specifically, Applicant submitted an Offer to Surrender the Original Patent with the original application as seen by the stamped postcard enclosed herewith. A true copy of the Offer to Surrender the Original Patent that was filed with this reissue application is enclosed herewith.

Moreover, Applicant is in the process of attempting to locate the original patent for surrender. Thus, the original patent or an Affidavit or Declaration as to loss or inaccessibility of the original patent will be filed before this reissue application is allowed.

#### ***Objections to the Drawings***

In paragraph 3 of the Office Action, the drawings were objected to because the top view in Figures 3 was missing semi-circular lines to designate the cross-section end of bars 22, 24, 26 and 28. In response, Applicant submits herewith Proposed Drawing Corrections

which add the cross-section ends of the bars 22, 24, 26 and 28, as required in the Office Action. Thus, Applicant requests approval of these proposed drawing changes.

### ***Duplicate of Claims***

In paragraph 4 of the office Action, it was noted that claims 19 and 22 are objected to under 37 CFR §1.75 as being substantially duplicate claims. In response, Applicant has amended the dependency of claim 22 to correct this error. Applicant apologizes for this error. Applicant believes that this objection has been overcome. Withdrawal of this rejection is respectfully requested.

### ***Claim Rejections Under 35 U.S.C. §112***

In paragraphs 5 and 6 of the Office Action, claims 2-7, 9, 10, 13, 19, 22 and 25 stand rejected under 35 U.S.C. §112 as being indefinite. In response, Applicant has amended claims 2, 3, 9, 13, 19, 22 and 25 and cancelled claims 4 and 10 to correct these errors. Applicant believes that these amendments to these claims overcomes these rejections. Therefore, withdrawal of these rejections is respectfully requested.

### ***Claim Rejections Under 35 U.S.C. §102***

In paragraphs 7-10 of the office Action, claims 18, 19 and 22 stand rejected under 35 U.S.C. §102(b). Specifically, claim 18 stands rejected in view of either U.S. Patent No. 2,173,020 to Kubach, or U.S. Patent No. 2,205,730 to Morgan, or U.S. Patent No. 5,076,177 to Chien, while claims 19 and 22 stand rejected in view of U.S. Patent No. 5,076,177 to Chien. In response, Applicant has amended independent claim 18 to overcome this rejection.

Specifically, independent claim 18 has been amended to recite a metal block comprising

- (1) a first rectangular metal plate member being a ***one-piece, unitary member***;
- (2) a second rectangular metal plate member being a ***one-piece, unitary member***; and

(3) a pair of spacer members rigidly and fixedly secured between the first inner surface and said second inner surface in a manner to form *at least one reinforcing bar and cement receiving cavity* and *a pair of end cavities* between the first and second metal plate members, with the at least one reinforcing bar and cement receiving cavity and the pair of end cavities being *arranged to align with corresponding cement receiving cavities of conventional concrete blocks*.

In other words, the metal block of the present invention of claim 18 is designed to be used with *conventional concrete blocks*. Clearly, this type of metal block is not shown or disclosed by the Kubach patent or the Morgan patent or the Chien patent. Therefore, withdrawal of these rejections is respectfully requested.

The Office Action does not appear to be giving patentable weight to the dimensional relationship of the parts of the metal block of the present invention so that it can be used with *conventional concrete blocks*. Applicant believes that the dimensional relationship of the parts of the metal block of the present invention to the dimensional relationship of the parts of *conventional concrete blocks* is important aspect of the present invention. Moreover, the dimensional relationship of the parts of *conventional concrete blocks* should also be given patentable weight in this case. While the claims use environmental structure (*conventional concrete blocks*) to define various elements of claim 18, these “environmental limitations” also should be given patentable weight and do not render the claims indefinite. In particular, the Federal Circuit in *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986) has held similar language, used in claims to satisfy 35 U.S.C. § 112, second paragraph. In particular, the *Orthokinetics* case involved a patent covering a pediatric wheel chair. The claims in the *Orthokinetics* case recited background or

environmental structure such as “an automobile” and various parts of the automobile. For example, claim 1 of the patent in the *Orthokinetics* case reads as follows:

1. In a wheel chair having a seat portion, a front leg portion, and a rear wheel assembly, the improvement wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof whereby said front leg is placed in support relation to the automobile and will support the seat portion from the automobile in the course of subsequent movement of the wheel chair into the automobile and the retractor means for assisting the attendant in retracting said rear wheel assembly upwardly independently of any change in the position of the front leg portion with respect to the seat portion while the front leg portion is supported on the automobile and to a position which clears the space beneath the rear end of the chair and permits the chair seat portion retracted rear wheel assembly to be swung over and set upon said automobile seat. (Emphasis added).

The Federal Circuit held that this claim complies with 35 U.S.C. § 112, second paragraph. In particular, the Federal Circuit stated:

The claims were intended to cover the use of the invention with various types of automobiles. That a particular chair on which the claims read may fit within some automobiles and not o[t]hers is of no moment. The phrase “so dimensioned” is so accurate as the subject matter permits, automobiles being of various sizes. See, Rosemont, Inc. v. Beckman Instruments, Inc., 727 F.2d 1540, 1547, 221 USPQ 1, 7 (Fed. Cir. 1984). As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, § 112, 2d ¶ requires nothing more. The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

Therefore, the uses of environmental structure are permissible to further define structure within a claim. Therefore, Applicant believes that independent claim 18 overcome the prior art of record. Likewise, Applicant believes the dependent claim 19 is believed to be allowable in view of the amendments to independent claims 18.

### ***Claim Rejections Under 35 U.S.C. §103***

In paragraphs 11-14 of the Office Action, claims 1-4, 8-10 and 21 stand rejected under 35 U.S.C. §103 as being unpatentable. In particular, claims 1-3, 8, 9 and 21 stand rejected in view of either Kubach or Morgan, while claims 1-4, 9 and 10 stand rejected in view of Chien. In response, Applicant has amended independent claim 1, as discussed below, and independent claim 18, as discussed above.

More specifically, independent claim 1 has been amended to recite all of the limitations of claim 18, as discussed above, and the third spacer member of claim 4. Accordingly, independent claims 1 and 18 have been amended to recite a metal block comprising

- (1) a first rectangular metal plate member being a ***one-piece, unitary member***;
- (2) a second rectangular metal plate member being a ***one-piece, unitary member***; and
- (3) a pair of spacer members rigidly and fixedly secured between the first inner surface and said second inner surface in a manner to form ***at least one reinforcing bar and cement receiving cavity*** and a ***pair of end cavities*** between the first and second metal plate members, with the at least one reinforcing bar and cement receiving cavity and the pair of end cavities being ***arranged to align with corresponding cement receiving cavities of conventional concrete blocks***.

Clearly, neither Kubach nor Morgan discloses the third spacer member. Therefore, Applicant respectfully submits that the rejections in view of either Kubach or Morgan have been overcome. Withdrawal of these rejections is respectfully requested.

Regarding the rejection in view of the Chien patent, Applicant respectfully submits that this patent fails to render obvious claims 1 and 18 as now amended. In particular, the first and second rectangular metal plate member are now claimed as being ***one-piece, unitary***



*members* with the spacers being rigid and non-movably coupled thereto. However, the display shelf of Chien is a collapsible type of member that has hinges. Clearly, the Chien patent fails to disclose or suggest the claimed structure. In fact, if the display shelf of Chien were modified to meet the claimed structure of independent claim 1, then this would totally destroy the purpose and teachings of the Chien patent.

Accordingly, Applicant respectfully submits that these rejections have been overcome by the amendments to independent claims 1 and 18. Withdrawal of these rejections is respectfully requested.

#### ***Allowed Claims***

In paragraph 15 of the Office Action, claims 11, 12, 14-17, 23, 24, 26 and 27 were indicated as allowed. Applicant wishes to thank the Examiner for the indication of allowability. Applicant has noted an error in claim 17, i.e., the phrase “said first and second vertical spacer members” lack a proper antecedent basis. Accordingly, this error has been corrected. Therefore, Applicant believes that these claims are now allowed.

#### ***Objected to Claims***

In paragraph 16 of the Office Action, claim 20 was indicated as being objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicant wishes to thank the Examiner again for this indication of allowable subject matter. In response, Applicant has amended claim 20 to place claim 20 in independent form. However, the word “vertical” has been removed from the phrase “vertical spacer members”. Applicant does not believe that this change affects the allowability of this claim in view of the reasons for allowance stated in paragraph 18 of the Office Action.

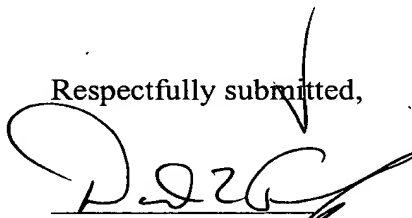
### *Allowable Claims*

In paragraph 17 of the Office Action, claims 5-7, 13 and 25 were indicated as being allowable if rewritten to overcome the rejection under 35 U.S.C. §112, set forth in the Office Action and to include all the limitations of the base claim and any intervening claims. Applicant wishes to thank the Examiner for this indication of allowable subject matter. In response, Applicant has amended claims 5 and 25 to place them in independent form. However, claim 5 has not been amended to include the limitations of intervening claim 3 since the Office Action does not appear to indicate that this limitation is relevant to the allowability of claim 5. Similarly, claim 25 has been amended to remove the word "vertical" from in front of the phrase "vertical spacer member". Again, Applicant does not believe that this affects the allowability of claim 25 in view of the reasons for allowance indicated in paragraph 18.

\* \* \*

By the above amendments to the claims, Applicant is hereby seeking to correct an error in the issued patent. Specifically, in the issued patent the allowed claims were overly narrow and did not adequately claim the disclosed subject matter.

Respectfully submitted,



David L. Tarnoff  
Attorney of Record  
on Behalf of Assignee  
Reg. No. 32,383

SHINJYU GLOBAL IP COUNSELORS, L.L.P.  
1233 Twentieth Street, NW, Suite 700  
Washington, D.C. 20036  
(202) 293-0444  
Dated: April 6, 2000

c:\Apr\F0375DT-US Amendment